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MAILED

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OFFICE OF PETITIONS

In re Patent of Garraffa	:	
Patent No. 5,678,541	:	
Issue Date: October 21, 1997	:	Decision on Petition
Application No. 08/616,223	:	
Filing Date: March 5, 1996	:	
Attorney Docket No. Atomic-1	:	

This is a decision on the petition under 37 C.F.R. § 1.378(b), filed December 22, 2010, to reinstate the above-identified patent.

The petition is **DISMISSED**.

Facts

The instant application was filed March 5, 1996.

Attorney Leonard Tachner handled prosecution of the instant application.

The application issued as a patent on October 21, 1997.

The 3.5 year maintenance fee of \$440 and a surcharge of \$65 were timely paid on October 22, 2001.

The 7.5 year maintenance fee could have been paid from October 21, 2004, to April 21, 2005, or with a surcharge from April 22, 2005, to October 21, 2005. The fee was not timely paid. As a result, the patent expired October 22, 2005.

The petition states the patent is owned by Atomic Aquatics. Dean Garraffa is the sole inventor and a principal of Atomic Aquatics.

On November 17, 2010, Garraffa contacted Janis Foreman, Tachner's Office manager, and requested she supply him with a tabular report showing the current status of Petitioner's patents handled by Tachner's firm.

During the creation of the report, Foreman noticed several of Petitioner's patents had expired as a result of non-payment of maintenance fees since early 2005.

Garraffa received the report on or about November 24, 2010. Thereafter, Garraffa promptly requested a meeting with Tachner to discuss the report. The petition states the expired status of the patents shocked Garraffa, as well as another principal of Petitioner.

The petition states, with emphasis added,

The declaration evidence shows that over a protracted period[,] beginning in 2005[,] Ms. Foreman experienced a psychological breakdown or psychotic episode as described by Dr. Albert.... The breakdown of Ms. Foreman caused her to fail in her office duties which included notifying the patentee of the need to pay maintenance fees.... **Only [in the] past few weeks has her strange and unexpected behavior come to light.**

Ms. Foreman has been a loyal and reliable employee of Tachner's office for more than thirty-two years. She did not exhibit any form of overt personality characteristics or behavior which would have led Mr. Tachner to anticipate that she would not have fulfilled her normal office duties as she had done for more than three decades. Based upon Dr. Albert's interview and diagnosis of Ms. Foreman, **it is only now understood that she was overworked and stressed beyond her limit ... but that she was "programmed" to hide her predicament for fear of losing her position.**

Tachner's declaration states,

[Foreman and I] have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney.... Her actions in dealing with clients, the U.S. Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communication are to be reviewed by me.

The petition is accompanied by a declaration by Samuel H. Albert, M.D., a practicing psychiatrist. Foreman met with Dr. Albert during late November 2010 at Tachner's request. Dr. Albert's declaration states,

Based upon [the] facts communicated to me, my reading of the Tachner and Foreman statements and my interview with Ms. Foreman, I have formed a preliminary medical opinion as follows:

Ms. Foreman's irrational behavior is a result of her reaction to a temporary but continually increasing workload which became more than she could handle....

[S]he evidently became so busy that she's lost the ability to bill clients in a timely manner and pay the firm's obligations when they were due....

She began feeling a sense of guilt for not being able to properly handle these responsibilities. She did not want to inform Mr. Tachner of these problems.... [S]he spent more time concerned with her problems [than] with solving her problems.

She began to do and say unreasonable and unrealistic things.... She lost any sense of reality.... Her goal became one of maintaining a sense of continuity and stability for Mr. Tachner even by misleading him and making false statements to him and to others. Ms. Foreman was suffering from an acute psychotic breakdown brought on by rising pressures at her most important environment, her workplace where she had succeeded for decades....

I believe Ms. Foreman's illness is amenable to treatment.

The instant petition does not appear to be the only petition filed by Tachner on behalf of Petitioner. Additional petitions include, but are not necessarily limited to:

1. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 5,803,073 on December 22, 2010,
2. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,761,163 on January 3, 2011,
3. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,463,640 on January 3, 2011,
4. A petition under 37 C.F.R. § 1.137(a) filed for Application No. 29/238,632 on January 12, 2011,
5. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,098,924 on January 24, 2011, and
6. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,347,766 on January 24, 2011.

Law

A grantable petition under 37 C.F.R. § 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to show unavoidable delay, the party must show "reasonable care was taken to ensure that the maintenance fee would be promptly paid."¹ The level of "reasonable care" required to be shown is the same as the level of "care or diligence ... generally used and observed by prudent and careful men in relation to their most important business."² When determining if a

¹ 37 C.F.R. § 1.378(b).

² *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). See also *Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was

period of delay has been shown to have been unavoidable, the Office will take "all the facts and circumstances into account" and will decide each petition "on a case-by-case basis."³

35 U.S.C. § 41(c)(1) states, with emphasis added, "The Director may accept the payment of any maintenance fee . . . after the six month grace period if the delay is *shown to the satisfaction of the Director* to have been unavoidable." Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

The Office and Congress have recognized the unavoidable standard can be very difficult to meet. During 1992, Congress considered the difficulty involved in reinstating a patent under the unavoidable. Congressional representatives described the unavoidable standard as inflexible, extremely hard to meet, too stringent and harsh.⁴ Congress did NOT take steps to make the unavoidable standard more flexible, easier to meet, less stringent, or less harsh. Instead, Congress determined that it would allow patent owners the ability to reinstate a patent under an "unintentional" standard as long as the petition was filed within 24 months of the expiration of the patent. Congress chose to continue requiring proof of unavoidable delay for petitions filed after the 24 month time period.

Analysis

The Error That Led to Non-Payment of the 7.5 year Maintenance Fee

The petition argues the 7.5 year fee was not paid as a result of an error by Foreman. However, the petition does not actually identify the error made by Foreman. In view of Petitioner's failure to identify Foreman's error, the Office is unable to conclude Tachner's reliance on Foreman not to make such an error was reasonable and prudent. In other words, the record fails to establish the failure to timely pay the fee was unavoidable.

Causation

The petition fails to prove the 7.5 year maintenance fee would have been paid absent Foreman's medical condition.

unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

³ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

⁴ "[The unavoidable] standard has been found to be extremely hard to meet. Some patent owners have lost their patent rights due to this inflexible standard." 138 CONG. REC. S16613, 16614 (September 30, 1992) (Rep. DeConcini) (emphasis added). "The unavoidable standard has proved to be too stringent in many cases." 138 CONG. REC. H1115 (October 3, 1992) (Rep. Hughes) (emphasis added). "The unavoidable standard is 'too stringent'. Some patent owners have lost their patent rights due to circumstances that do not warrant this harsh result, but that could not be considered 'unavoidable' under current law." 138 CONG. REC. E1688 (June 4, 1992) (extension of remarks of Rep. McCollum) (emphasis added).

The petition asserts Foreman was “overworked and stressed beyond her limits.”

Dr. Albert’s statement indicates:

1. Tachner began continuously increasing Foreman’s workload on an unidentified date;
2. Foreman became overworked and stressed;
3. “[T]he Tachner law firm is a very busy firm and Ms. Foreman has a “heavy workload with many varied and important business responsibilities,” and
4. Foreman was unable “to vent her frustration, the worry, and concern” she felt as she fell further and further behind in her work.

Dr. Albert indicates Foreman eventually suffered an acute psychotic breakdown. However, Dr. Albert does not identify the date, or a specific time-frame during which, Foreman transitioned from being overworked, stressed employee to an employee suffering from an acute psychotic breakdown. In other words, the record fails to prove Foreman’s error, resulting in the expiration of the patent during October 2005, took place during the period of time Foreman was suffering from an acute psychotic breakdown.

Even if Foreman was suffering from an acute psychotic breakdown during the entire period from early 2005 until the date the petition was filed, the record would be insufficient to establish causation. The petition appears to simply assume the error was the result of the medical condition. However, the record implies the error may have well been the result of other factors, such as being overworked and being placed under a heavy workload.

Foreman’s Work Environment

On an unidentified date, Tachner began to continuously increasing Foreman’s workload, As a result of the heavier workload, she became overworked, stressed, and too busy to properly perform her duties.

In general, an inverse relationship exists between quality and an employee’s workload. In other words, the chance of an employee making an error when performing a task increases as the time the employee is allowed to spend on the task decreases. Therefore, a reasonable and prudent employer, treating the supervision of an employee as the employer’s most important business, would not simply assume an employee’s past quality of work would not suffer as the employer continuously increased the employee’s workload. Instead, such an employer would take steps to ensure the employee could adequately handle the new workload without a drop in quality. The record fails to indicate Tachner took any steps to ensure Foreman could adequately handle the new workload without a drop in quality.

If an employer has created a work environment in which employees feel 100% comfortable bringing workload issues to the employer’s attention, the employer might be reasonable in expecting an employee to inform the employer if the employee’s workload begins to impact the quality of the employee’s work. However, the record fails to prove Tachner created such a work environment. For example, the petition states, with emphasis added, “[Foreman] was

overworked and stressed beyond her limit ... [but was] “programmed” to hide her predicament *for fear of losing her position.*”

Tachner’s Continued Reliance on Foreman After the Expiration the Patent

In order for relief to be warranted under 37 C.F.R. § 1.378(b), the record must establish the entire delay in the submission of the fee was unavoidable.

If the expiration of the instant patent been discovered on an earlier date, a petition to reinstate the patent could have been filed on an earlier date. Therefore, the Office must determine if the failure to discover the expiration of the patent on an earlier date was unavoidable.

The petition asserts:

1. Foreman has been a reliable employee for more than thirty-two years;
2. “Only [in the] past few weeks has her strange and unexpected behavior come to light;” and
3. “[I]t is only now understood that she was overworked and stressed beyond her limit.”

Despite the assertions above, the evidence is insufficient to demonstrate Tachner had no reason to suspect Foreman’s past work was unreliable prior to discovering the expiration of the patent during November 2010.

The instant decision will discuss facts involving Patent No. 6,205,885, since such facts demonstrate Tachner had reasons to doubt the reliability of Foreman’s work well before November 2010.

Patent No. 6,205,885 expired as a result of Foreman removing all future maintenance fee due dates for all of a client’s patents from the docketing system. Tachner filed a renewed petition to reinstate the patent under 37 C.F.R. § 1.378(b) on July 31, 2008. Tachner clearly recognized Foreman had made an error. For example, page 2 of the petition stated, with emphasis added,

[The attached Tachner declaration indicates] Ms. Foreman made a *profound clerical error* ... [as a result of] Ms. Foreman’s distraction, or confusion or unusual lack of dependable adherence to client instructions.

Tachner’s declaration filed with the July 31, 2008 petition references concerns Tachner has concerning Foreman’s recent conduct and her current ability to perform her job. The declaration stated,

In retrospect, it seemed strange to me that neither we nor the client received a maintenance fee reminder for the ‘855 patent. Ms. Foreman assured me that we had not received such document.... [I also did not receive the prior decision mailed April 9, 2008.] Ms. Foreman maintained that the April 9 decision letter was not received by our office....⁵

⁵ Paragraph 5.

I've not previously had reason to doubt [Foreman's] work or question her actions....⁶

I am taking action immediately to reduce Ms. Foreman's duties in the office.⁷

In view of the prior facts, Tachner appears to have had reasons to doubt Foreman's reliability *at least* as early as July 31, 2008, which was almost 28 months before he discovered the expiration of the instant patent. Despite the existence of such reasons, the record fails to indicate Tachner took any steps to determine the identity of any other patents which may have expired as a result of error(s) by Foreman. The record fails to indicate Tachner would not have learned of the expiration of the instant patent on an earlier date if such steps had been taken. Therefore, the showing of record is insufficient to prove the *entire* delay in the submission of the 7.5 year maintenance fee was unavoidable.

Any request for reconsideration should discuss the extent to which Tachner was, or was not, reasonable in failing to take steps after July 31, 2008, to identify patents which may have unintentionally expired as a result of an error by Foreman.

Any request for reconsideration should clearly identify *all* applications in which Tachner filed a petition under 37 C.F.R. § 1.137 between October 1, 2004, and February 1, 2011. The request should also identify and fully discuss any errors by Foreman and/or Tachner, which contributed to the abandonment of each application.

Any request for reconsideration should clearly identify all patents in which Tachner filed a petition under 37 C.F.R. § 1.378 between October 1, 2004, and February 1, 2011. The request should also identify and fully discuss any errors by Foreman and/or Tachner, which contributed to the expiration of the patent.

Any request for reconsideration should clearly identify all patents, that Tachner is aware of, where a party other than Tachner filed a petition under 37 C.F.R. § 1.378(b) between October 1, 2004, and February 1, 2011, asserting Tachner, Foreman, or Tachner's firm made an error which contributed to the expiration of the patent.

Foreman's Authority to Take Various Actions

The Office is concerned statements in the instant petition involving Foreman's authority, or lack of authority, to take various actions. Information provided with petitions filed in Patent No. 6,205,885, appears to indicate Foreman was allowed to take actions in response to instructions from clients without first discussing the matter with Foreman. However, Tachner's declaration in this case states,

[Foreman and I] have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney.... Her actions in dealing with clients, the U.S.

⁶ Paragraph 7.

⁷ Paragraph 9.

Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communication are to be reviewed by me.

Any request for reconsideration should *fully* discuss the extent to which Foreman was, or was not, permitted to take actions involving the payment of maintenance fees without first discussing the matter with Tachner.

In view of the prior discussion, the showing of record is not sufficient to establish that the entire delay was unavoidable within the meaning of 37 C.F.R. § 1.378(b).

The Address of Record

The address on the petition is different than the address of record. As a courtesy, the Office is mailing the instant decision to the address on the petition. However, future communications will be mailed solely to the current address of record absent the filing of a request to change the address of record.

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision and include a non-refundable petition fee of \$400. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled “Renewed Petition under 37 CFR 1.378(b).” This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

After a decision on the petition for reconsideration is issued, no further reconsideration or review of the matter will be undertaken by the Director. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner’s decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must **prove** that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to “show” that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Since the petition is dismissed, petitioner may request a refund of the maintenance fee and surcharge. Petitioner is reminded that if a request for reconsideration is later filed along with the \$400 fee, the \$400 will not be refunded. A request for a refund should be sent to: Mail Stop 16,

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.⁸ Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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⁸ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.